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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/828,245

04/09/2001

Mitchell E. Goodman

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06/23/2004

MOTOROLA, INC  
INTELLECTUAL PROPERTY SECTION  
LAW DEPT  
8000 WEST SUNRISE BLVD  
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EXAMINER

CARTER, AARON W

ART UNIT

PAPER NUMBER

2625

DATE MAILED: 06/23/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/828,245

Applicant(s)

GOODMAN ET AL.

Examiner

Aaron W Carter

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Claim Objections*

1. Claim 1 is objected to because of the following informalities: In claim 1, line 9; the term "though" should be "through".

Appropriate correction is required.

- Claim 7 is objected to because of the following informalities: In claim 7, line 8, the term "with" should be "within".

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 5-9, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,680,205 to Borza.

As to claims 1 and 7, Borza discloses a fingerprint acquisition assembly comprising:

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At least one camera for capturing an electronic image at a first focal range (column 1, lines 48-51, wherein the second lens can be used to view objects in the vicinity of the apparatus);

At least one optical interface for providing a macro image to the at least one camera at a second focal range (column 1, lines 59-67, the prism is used to receive the fingerprint image); and

Wherein the at least one camera pivots within the acquisition assembly for capturing a fingerprint image in the second focal range through the at least one optical interface (column 1, lines 59-62, wherein the apparatus includes a tiltable or swiveling mounting for the auxiliary lens and for the *camera*, see also Figs. 2a and 2b).

As to claims 2 and 8, Borza discloses a fingerprint acquisition assembly as in claim 1, wherein the optical interface is a prism (column 2, lines 39-48 and Fig. 1a, element 26a).

As to claims 3 and 9, Borza discloses a fingerprint acquisition assembly as in claim 1, wherein the optical interface is a mirror and lens assembly (column 2, lines 59-67).

As to claims 5 and 12, Borza discloses a fingerprint acquisition assembly as in claim 1, further wherein a finger is placed directly on a surface of the prism for acquisition by the at least one camera (Fig. 1A elements 26a and F).

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As to claims 6 and 13, Borza discloses a fingerprint acquisition assembly as in claim 1, further comprising a display for viewing images generated by the at least one camera (Fig. 5, "Monitor").

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borza in view of US Patent 6,366,682 to Hoffman et al. ("Hoffman").

As to claims 4 and 10, Borza discloses a fingerprint acquisition assembly as in claim 1, wherein the acquisition assembly can be connected to a two-way communication device (Fig. 5, wherein it is inherent that a computer is a two-way communication device)

Borza does not disclose expressly wherein the acquisition assembly can be connected to a two-way communications device for electronic transmission of the image to a remote location.

Hoffman discloses a fingerprint acquisition assembly connected to a two-way communications device for electronic transmission of the image to a remote location (column 4, lines 46-57).

Borza & Hoffman are combinable because they are from the area of biometrics.

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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to connect the acquisition assembly to a two-way communications device for electronic transmission of the image to a remote location as taught by Hoffman.

The suggestion/motivation for doing so would have been that by sending fingerprint images to a remote location and performing authorization or identification at a remote location prevents fraud by preventing a user from acquiring copies of fingerprint images or from tampering with the verification process (column 7, lines 14-24).

Therefore, it would have been obvious to combine Borza with Hoffman to obtain the invention as specified in claims 4 and 10.

As to claim 11, please refer to rejections made for claims 4 and 10 above, please also see Hoffman, Fig. 1.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6,532,035 to Saari et al. discloses a mobile phone with a pivoting camera for capturing images at two separate focal ranges.

US Patent 6,064,753 to Bolle et al. discloses a fingerprinting device connected to a network.

US Patent 6,487,662 to Kharon et al. discloses a fingerprint acquisition device.

US Patent 5,546,471 to Merjanian discloses a fingerprint acquisition device.

US Patent 4,538,181 to Taylor discloses a fingerprint acquisition device.

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US Patent 6,339,508 to Nozawa et al. discloses a fingerprint acquisition device.

US Patent 5,222,152 to Fishbine et al. discloses a fingerprint acquisition device.

US Patent 6,744,910 to McClurg et al. discloses a fingerprint acquisition device.

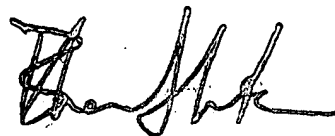
US Patent 6,177,950 to Robb discloses a fingerprint acquisition device.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron W Carter whose telephone number is (703) 306-4060. The examiner can normally be reached on 7am - 3:30 am (Mon. - Fri.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on (703) 308-5246. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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